

REMARKS

This application has been reviewed in light of the Office Action dated August 9, 2006. Claims 31-58 are presented for examination, of which Claims 31, 35, and 37-40 are in independent form. Claims 31, 35, and 37-40 have been amended. Favorable reconsideration is requested in view of the foregoing amendments and the following remarks.

Rejections

Claims 35, 36, 38, 40, 44-46, 50-52, and 56-58 have been rejected under 35 U.S.C. § 103(a), as being unpatentable over the patent to Umeno (U.S. Patent No. 5,392,131) in view of the patent to Nakayama et al. (U.S. Patent No. 5,361,143). Claims 31-34, 37, 39, 41-43, 47-49 and 53-55 have been rejected under 35 U.S.C. § 103(a), as being unpatentable over the patent to Tahara et al. (U.S. Patent No. 5,666,211) in view of the patent to Nakayama et al.

Response to Rejections

In response, while not conceding the propriety of the rejections, independent Claims 31, 35, and 37-40 have been amended. Applicant submits that as amended, these claims are allowable for the following reasons.

Independent Claims 35, 38, and 40

Independent Claim 35 relates to an image transmitting apparatus for displaying names of or images representing a plurality of files at least one of which contains image data of a document image and for enabling the manual selection one of the plurality of files, whose name

or image is displayed, for transmission. The apparatus comprises a memory, a display unit, a file selection unit, a controller, and a transmitting unit. The memory is adapted to store each of the plurality of files including the at least one file containing the document image so that the document image is stored as image data in a plurality of formats. The display unit is configured to display the plurality of names of or the plurality of images representing the plurality of files stored in the memory. The file selection unit is adapted for a user to select at least one of the plurality of files in the memory whose name or image is displayed on the display unit. The controller is adapted to read out the data from the file which was selected by a user through the file selection unit.

Claim 35 has been amended to recite that the plurality of formats in which the document image is stored includes a non-contact-requiring format that does not require contacting a destination apparatus to determine whether the format of the document image is suitable to the destination apparatus and contact-requiring format that requires contacting the destination apparatus to determine whether the format of the document image is suitable to the destination apparatus.

Claim 35 has also been amended to recite that the controller is adapted to determine whether the format of the data from the user-selected file is a non-contact-requiring format or a contact-requiring format, adapted to contact the destination apparatus to determine whether the format of the data from the user-selected file is suitable to the destination apparatus only when the format of the data from the user-selected file is the contact-requiring format, and adapted to refrain from contacting the destination apparatus to determine whether the format of the data

from the user-selected file is suitable to the destination apparatus when the format of the data from the user-selected file is the non-contact-requiring format.

Claim 35 has been further amended to recite that in the event the selected file is the file containing image data of the document image in the contact-requiring format, the controller reads out the image data of the document image in a format suitable for a destination apparatus after contacting the destination apparatus to determine whether the format of the user-selected file is suitable to the destination apparatus.

Also, Claim 35 has been amended to recite that the transmitting unit is adapted to transmit the data read out by the controller to the destination apparatus without contacting the destination apparatus to determine whether the format of the data to be transmitted is suitable to the destination apparatus when the format of the data to be transmitted is the non-contact-requiring format, and adapted to contact the destination apparatus to determine whether the format of the data read out by the controller is suitable to the destination apparatus before transmitting the read out data when the format of the read out data is the contact-requiring format.

One non-limiting example of some of these added features is shown in steps S601-S607 in Figure 6 of the present application.

In contrast, the patents to Umeno and Nakayama et al. are not understood to disclose or suggest that the plurality of formats in which the document image is stored includes a non-contact-requiring format that does not require contacting a destination apparatus to determine whether the format of the document image is suitable to the destination apparatus and contact-requiring format that requires contacting the destination apparatus to determine whether the

format of the document image is suitable to the destination apparatus, as recited by amended Claim 35.

In addition, these citations are not understood to disclose or suggest the controller is adapted to determine whether the format of the data from the user-selected file is a non-contact-requiring format or a contact-requiring format, adapted to contact the destination apparatus to determine whether the format of the data from the user-selected file is suitable to the destination apparatus only when the format of the data from the user-selected file is the contact-requiring format, and adapted to refrain from contacting the destination apparatus to determine whether the format of the data from the user-selected file is suitable to the destination apparatus when the format of the data from the user-selected file is the non-contact-requiring format, as also recited by amended Claim 35.

Therefore, these citations are also not understood to disclose or suggest that in the event the selected file is the file containing image data of the document image in the contact-requiring format, the controller reads out the image data of the document image in a format suitable for a destination apparatus after contacting the destination apparatus to determine whether the format of the user-selected file is suitable to the destination apparatus, as recited by amended Claim 35.

Finally, these citations are not understood to disclose or suggest that the transmitting unit is adapted to transmit the data read out by the controller to the destination apparatus without contacting the destination apparatus to determine whether the format of the data to be transmitted is suitable to the destination apparatus when the format of the data to be transmitted is the non-contact-requiring format, and adapted to contact the destination apparatus to determine whether the format of the data read out by the controller is suitable to the destination apparatus before

transmitting the read out data when the format of the read out data is the contact-requiring format, as also recited by amended Claim 35.

Rather, the patent to Umeno is understood to relate to a conventional image transmission apparatus, while the patent to Nakayama et al., which was cited to show an apparatus for determining format compatibility, is understood to always contact the destination apparatus to determine whether the destination apparatus can receive color image data, regardless of whether the image data to be sent is color image data, as shown in steps 61, 62, 63, 68, 69, and 70 in Figure 8, as discussed at column 64, line 67 through column 65, line 27.

MPEP § 2142 requires the cited art to disclose or suggest all the claimed features to establish a prima facie case of obviousness. Here, since the cited art is not understood to disclose or suggest at least four features of amended Claim 35, Applicant submits that the Office has not yet established a prima facie case of obviousness against amended Claim 35. Therefore, Applicant respectfully requests that the rejection of Claim 35 be withdrawn. And since amended Claims 38 and 40 are corresponding method and computer program claims, Applicant respectfully requests that the rejection of these claims be withdrawn for corresponding reasons.

Independent Claims 31, 37, and 39

Independent Claim 31 relates to an image processing apparatus comprising an image reading unit, a manually controlled input unit, a file creating unit, and a controller. The file creating unit is adapted to create a file in a memory at a manually designated destination into which image data corresponding to a document image will be stored, and from which the image data will be transmitted in response to an instruction by a user. The controller is adapted to

register the document image which was read by the image reading unit both as color image data and as monochrome image data in the file which was created by the file creating unit at the manually designated destination.

Claim 31 has been amended to recite the apparatus is for enabling manual designation of a plurality of image-data storage destinations for image data that can be read in a plurality of reading modes prior to transmission of image data from the storage destination.

Claim 31 has also been amended to recite that the image reading unit is adapted to read the document image in a plurality of reading modes and to generate color image data of the document image and monochrome image data of the document image.

Claim 31 has been further amended to recite that the manually controlled input unit designates a plurality of storage destinations in a memory of image data corresponding to the document image read by the image reading unit in response to an instruction by a user.

Claim 31 has, in addition, been amended to recite that the input unit comprises a display: configured to display a plurality of storage destinations in a memory into one of which color image data of the document image and monochrome image data of the document image will be stored in response to an instruction by the user designating one of the displayed storage destinations; and configured to display a plurality of reading modes including a color reading mode and a monochrome reading mode in one of which the document image will be read by the image reading unit in response to an instruction by the user designating one of the displayed reading modes.

Finally, Claim 31 has been amended to recite that the controller is adapted to register the document image which was read by the image reading unit both as the color image data and as

the monochrome image data in the file which was created by the file creating unit at the manually designated destination after designating one of the reading modes displayed by the input unit.

One non-limiting example of some of these added features is shown in boxes 201 and 203 in Figure 2 of the present application.

In contrast, the patents to Tahara et al and Nakayama et al. are not understood to relate to an apparatus for enabling manual designation of a plurality of image-data storage destinations for image data that can be read in a plurality of reading modes prior to transmission of image data from the storage destination, comprising an image reading unit adapted to read the document image in a plurality of reading modes and to generate color image data of the document image and monochrome image data of the document image, and a manually controlled input unit that designates a plurality of storage destinations in a memory of image data corresponding to the document image read by the image reading unit in response to an instruction by a user, comprises a display: configured to display a plurality of storage destinations in a memory into one of which color image data of the document image and monochrome image data of the document image will be stored in response to an instruction by the user designating one of the displayed storage destinations; and configured to display a plurality of reading modes including a color reading mode and a monochrome reading mode in one of which the document image will be read by the image reading unit in response to an instruction by the user designating one of the displayed reading modes, as recited by amended Claim 31. In addition, these citations are not understood to disclose or suggest that a controller is adapted to register the document image which was read by the image reading unit both as the color image data and as the monochrome image data in the file which was created by the file creating unit at the manually designated

destination after designating one of the reading modes displayed by the input unit, as recited by amended Claim 31.

Rather, the patent to Nakayama is understood to relate to a conventional format compatibility apparatus that was cited to show reading and storing of black image data and color image data. And Figure 2 of the patent to Tahara et al., which was cited to show an input unit that designates a storage destination, is understood to merely permit the storage of image data at a single destination, i.e., the optical disk cassette 20, by pressing a storage destination transmission data storage designation switch 176 for designating that transmission-use image compressed data be stored in an optical disk cassette 20, and by pressing a received data storage destination switch 177 for designating that received image compressed data be stored in the cassette 20. In addition, this patent is not understood to disclose plural scanning modes or the display of plural scanning modes to be selected by the user.

As noted above, MPEP § 2142 requires the cited art to disclose or suggest all the claimed features to establish a prima facie case of obviousness. Here, since the cited art is not understood to disclose or suggest several features of amended Claim 31, Applicant submits that the Office has not yet established a prima facie case of obviousness against amended Claim 31. Therefore, Applicant respectfully requests that the rejection of Claim 31 be withdrawn. And since amended Claims 37 and 39 are corresponding method and computer program claims, Applicant respectfully requests that the rejection of these claims be withdrawn for corresponding reasons.

Conclusions

The other rejected claims in this application depend from one or another of the independent claim discussed above and, therefore, are submitted to be patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, individual consideration or reconsideration, as the case may be, of the patentability of each claim on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

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